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GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

EXAMINER	
NASH, LASHANYA RENEE	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/877,597
Filing Date: June 08, 2001
Appellant(s): SCHWAB ET AL.

John G. Posa

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 November 2007 appealing from the Office action mailed 25 January 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6654797	**KAMPER**	**11-2003**
6512526	**MCGLOTHLIN**	**1-2003**
6029196	**LENZ**	**2-2000**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamper, in view of McGlothlin et al. (US Patent 6,512,526), hereinafter referred to as Kamper and McGlothlin.

In reference to claim 1, Kamper discloses a method for transferring configuration preferences to a plurality of computers employing a removable storage device, (abstract). Kamper explicitly discloses:

- A method (Figure 4; column 2, lines 1-26) of transferring user preferences (i.e. configuration data allocated to different personnel; column 5, line 54 to column 6, line 11; Figure 3-item John Doe), comprising the steps of:
    - Providing a transportable data storage medium, (column 3, line 56 to column 4, line 5; Figure 3);
    - Recording on the transportable data storage medium, at a first computer (i.e. smart card configured with configuration data subsequent to the physical setup of the server), information relating to a user's computer configuration preferences, (column 5, lines 54 to column 6, line 11);
    - Receiving the transportable data storage medium at a second computer, (i.e. the removable storage device reader is easily moved and coupled to a plurality of servers, one after another; column 5, lines 20-27);
    - At least temporarily configuring the second computer in accordance with the information stored on the transportable medium, (i.e. a single smart card to be used to configure a plurality of servers; columns 6-7).

However, Kamper fails to expressly disclose that the configuration data is unique information relating to a particular user's computer configuration preferences, including information relating to the user's preferred desktop graphical interface. Nonetheless, these were well known features in the art at the time of invention, as further evidenced by McGlothlin. Therefore, it would have been obvious to

accordingly modify the method as disclosed by Kamper, for one of ordinary skill in the art at the time of the invention.

In an analogous art, McGlothlin discloses a method that to allow customization of an individual user's desktop of a personal computer system environment (abstract; Figure 6). McGlothlin discloses the method wherein stored configuration data is unique information relating to a particular user's computer configuration preferences (i.e. desktop layout for each user (column 4, line 22- column 5, line 31); including information relating to the user's preferred desktop graphical interface (i.e. desktop layout includes graphical portions of desktop components; column 5, lines 32-column 6, line 6). One of ordinary skill in the art would have been motivated to implement this modification so as further allow configuration of the computing devices (i.e. including the graphical user interface) to be based on the preferences and expertise of different users, thereby increasing ease of use (Kamper column 5, line 65-column 6, line 5).

In reference claim 3, Kamper shows the method wherein storage medium includes information relating to wire or wireless network or dialup communication preferences, (i.e. IP address; hostname; gateway; column4, lines 6-13).

In reference claim 4, Kamper shows the method wherein storage medium includes information relating to one or more user files or information relating to a user file, (i.e. client boot files; column 3, lines 4-28).

In reference to claim 5, Kamper shows the method further includes the step of accessing a remote location to at least temporarily configure the second computer in accordance with the information stored on the transportable storage medium, (column3, lines 4-28; Figure 1).

In reference to claim 6, Kamper shows the method wherein the remote location includes data or an application program (i.e. applications) desired by the user at the second computer, (column3, lines 4-28; Figure 1).

In reference to claim 7, Kamper shows the method wherein the step of at least temporarily configuring the second computer occurs through re-booting the second computer or through a different user log-on (column 4, lines 1-10).

In reference to claim 8, Kamper shows the method wherein the storage medium uses a magnetic, optical, magneto-optical, or semiconductor memory, (column 3, line 56 to column 4, line 5; column 5, lines 45-65).

In reference to claim 9, McGlothlin shows prompting the user to retain the storage medium following the reconfiguration of second machine (column 6, lines 39-56).

In reference to claim 10, Kamper shows the method wherein the storage medium is in the form of a disk or card, (i.e. smart card; column 3, line 56 to column 4, line 5; column 5, lines 45-65; Figure 3).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamper and McGlothlin as applied to claim 1, in view of Lenz (US Patent 6,029,196), hereinafter referred to as Lenz.

In reference to claim 11, Kamper and McGlothlin disclose substantial features of the claimed invention such as storing user files on the storage medium (column 3, lines 5-26), and storing the user files at a second computer (i.e. storage device created at a remote place; column 7, lines 17-28). However, Kamper and McGlothlin do not explicitly disclose that the user files are updated in accordance with the user at the second computer. Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to accordingly modify the method as disclosed by Kamper and McGlothlin, as further evidenced by Lenz.

In an analogous art, Lenz discloses a method for configuration of client preferences and settings in a computer environment, wherein updates to client files are used to replace existing files (column 2 lines 12-14). One of ordinary skill in the art

would have been so motivated to implement this modification so as to update the user files on the storage medium at the second computer replacing existing user files from the first computer, thereby alleviating the need to for users to manually update their stored preferences and settings, (Lenz column 1, lines 12-24).

(10) Response to Argument

In considering Appellants arguments, the following comments are noted:

(I) Appellant contends that none of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store user data.

(II) Appellant contends that none of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store data to be used in configuration of a particular graphical user interface.

(III) Appellant contends that the type of information transferred in accordance with Kamper does not lend itself to user updating since it is used for network configuration purposes across a broad range of server devices.

In considering (I), Appellant contends that none of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store user data. Examiner respectfully disagrees. Examiner contends that Kamper expressly discloses the use of a removable storage device to store configuration data. Specifically, Kamper discloses employing a smart card (Figure 3; column 5, lines 45-53)

in addition to various conventional forms of transportable data storage mediums (e.g. floppy disk, CD-ROM, optical disk) for storing configuration information (column 3, line 60-column 4, line 5). Examiner agrees that Kamper discloses examples of configuration data that may be included on the aforementioned storage media (i.e. IP address of the server, the hostname, the netmask, etc.; column 4, lines 6-13). However, the disclosed examples of configuration data related to networking does not teach away from storing additional types of configuration data that is specific to user preferences as suggested by Appellant. Examiner further asserts that McGlothlin is cited to teach configuration information that is inclusive of user data, and even more particularly the data for user preferred desktop configuration. McGlothlin discloses that in an environment where more than one user is able to employ the same computer device, the configuration information includes customized user desktop graphical interface information "so that each user can have his or her own unique desktop layout" (column 6, lines 60-65). For example, as an individual User A employs the computer device and completes their log-in process, the particular configuration information associated with that user A is accessed in order to modify the computer's graphical display according to their desktop layout preferences (column 6, line 65-column 7, line 25). Therefore, it is evident that McGlothlin expressly discloses user data that is considered configuration data. In response to applicant's argument that McGlothlin is nonanalogous art it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McGlothlin is directed towards the problem in which Appellant's claimed invention seeks to address regarding configuring a computer device according to the customized graphical desktop layout of an individual user while in a multiple user environment, (Specification page 1, lines 10-17). Furthermore, Examiner asserts the combination of Kamper and McGlothlin would be obvious because the simple substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Therefore, it would have been obvious to one skilled in the art to substitute the configuration data components (i.e. networking data) of the transportable data storage medium taught by Kamper, with the configuration data components regarding user desktop layout as taught by McGlothlin to achieve the predictable result of configuring a computer device using user preference information uploaded from the removable storage device.

In considering (II), Appellant contends that none of the various embodiments disclosed in Kamper in any way suggest the use of a removable storage device to store data to be used in configuration of a particular graphical user interface. Examiner respectfully disagrees. Examiner further notes that Appellants contends that Kamper teaches away from employing a display device for configuration purposes. Examiner asserts that the portion of Kamper cited by Appellant to support this notion of "teaching away" is regarding a configuration technique using additional hardware devices (i.e. terminal, keyboard, mouse) that are employed only for configuration and later not

needed (column 1, lines 35-51). Subsequently, the aforementioned additional hardware devices are transported to each computing device requiring configuration for the manual input of configuration data (column 7, lines 24-28). However, the combination of Kamper and McGlothlin teaching stored user data to be used for configuration of a particular graphical user interface, results in both the display devices and the graphical user interfaces being employed for uses other than mere configuration and does not require manual input of the configuration data at each device (McGlothlin; column 5, lines 57-column 6, line 24; column 6, line 57-column 7, line 14). Furthermore, Examiner asserts that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton* 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See MPEP 2145. Also, Examiner also asserts that the combination of Kamper and McGlothlin would increase "ease of use". Kamper expressly discloses that configuration and physical setup of a computing device can be "allocated to different personnel with different levels of technical expertise" , wherein Kamper goes on to say that the level of technical expertise for the user is little to none for automatic configuration with smart card (column 5. lines 26-35). Thus, it is evident that employing the removable storage device for the configuration of user display preferences further increases the ease of use for users with limited technical knowledge, as the user is merely required to insert a smart card, or other conventionally used storage device, in order to accomplish configuring the computer for their customized desktop layout for that computer and other computers

subsequently used. In other words, the combination of Kamper and McGlothlin would be easy for a typical user, without much technical computing expertise, who desires to use a computing device and quickly carry out customized configuration of that device. Also, Examiner asserts that it would be obvious to combine Kamper and McGlothlin to teach use of the removable storage device to store data to be used for configuration of particular graphical user interface data for the reasons discussed previously in addressing (I), regarding simple substitution.

In considering (III), Appellant contends that the type of information transferred in accordance with Kamper does not lend itself to user updating since it is used for network configuration purposes across a broad range of server devices. Examiner respectfully disagrees. Examiner asserts that as previously discussed in addressing (I), the combination of Kamper and McGlothlin teaches a transportable data storage medium recording unique information relating particularly to a user's computer configuration preferences, including information relating to the user's preferred desktop graphical interface. Therefore, the references are not limited to employing network configuration data, but also configuration data particular to a user. Thus, the type of information taught by the combination of Kamper and McGlothlin, specifically data relating to a user's computer configuration preferences, does lend itself for user updating. Also, in response to applicant's argument that Lenz is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant

was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Lenz is directed towards the particular problem in which Appellant's claimed invention seeks to address regarding configuration of a client system without requiring manual user interaction (i.e. automatic configuration), (Specification page 2, lines 4-15). It is also important to note that Lenz does not teach away from client controlled configuration as suggested by Appellant. Rather, Lenz shows evidence directly to the contrary where the user (i.e. client) controls initiation of the configuration sequence (column 1, line 64-column 2, line 5). Furthermore, Examiner asserts that accordingly modifying the teachings of Kamper and McGlothlin with the teachings of Lenz would be obvious because a particular technique of updating user files for client configuration was recognized as part of the ordinary skill capabilities of one skilled in the art at the time of the invention. Therefore, it would have been obvious to one skilled in the art to apply the known technique of storing updated user files as taught by Lenz (column 2, lines 12-17) to improve the known device of the transportable data storage medium as taught by Kamper and McGlothlin for the predictable results of storing updated user data on the aforementioned transportable storage medium. For example, referring again to a User A, it would be obvious that upon User A modifying the preferred desktop layout during use, such as adding an icon to the desktop, that the user file reflecting this update would be loaded onto the smart card of User A which stores the user's associated user desktop graphical interface files. In addition, Examiner asserts that Appellant's arguments regarding the configuration data only being read from the removable storage

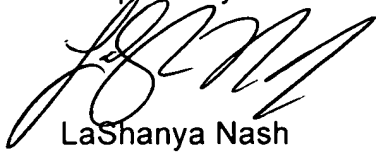
device if the computer finds the configuration has not already been installed, is not commensurate with the claim language. The limitations of the claim 11 do not recite a requirement for automatic reconfiguring of the computer device based on the updated user files, but rather recites that the user files stored on the storage medium are updated in accordance with the use of the second computer. Also, claim 11 does not recite language that either explicitly or implicitly excludes the resulting functionality, for arguments sake, suggested by Appellant (i.e. 'to change the profile, a user would have to clear or erase the current configuration profile stored in the server... ", see Appeal Brief page 6) to render the combination non-obvious. Therefore, Appellant's arguments fail to present evidence which supports that notion that the resulting combination of Kamper, McGlothlin and Lenz does not lend itself to updating and thusly are non-obvious.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



LaShanya Nash

Art Unit 2153

Conferees:

Lynne Browne
APPEAL PRACTICE SPECIALIST, TQAS
TECHNOLOGY CENTER 2100

Glenton Burgess

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100